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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,945	05/04/2005	Peter Preishuber-Pflugl	DB 054036	9681

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NOVAK DRUCE DELUCA & QUIGG, LLP
1300 EYE STREET NW
SUITE 400 EAST TOWER
WASHINGTON, DC 20005

EXAMINER	
PASTERCZYK, JAMES W	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/533,945	PREISHUBER-PFLUGL ET AL.	
	Examiner	Art Unit	
	J. Pasterczyk	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 5/4/05.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-17 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 5/4/05.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. This Office action is in response to the preliminary amendment filed 5/4/05.

2. The abstract of the disclosure is objected to because it could easily include definitions of the metals of the compound used in the catalyst as well as preferred identities for the various E groups while staying within one page. Correction is required. See MPEP § 608.01(b).

3. The specification is objected to because the coefficients on the E groups should all be consistently superscripted, subscripted, or on the same line as the E, instead of being inconsistent as they are now.

4. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the ligands being thiazolylaminophenols, does not reasonably provide enablement for these ligands being anything else. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The sole working examples of the ligands of the present invention are thiazolylaminophenols, although there is a universe of prophetic examples in which the various E groups are various combinations of oxygen, sulfur, selenium, tellurium, imino, methylene, and phosphino groups. Although the chemistry of these various groups is somewhat similar, it is not identical enough so that one of ordinary skill in the art would be able to make a simple substitution of one group for another during the preparation of the various compounds. This broad group of combinations and permutations is nothing but an invitation to experiment on the part of the practitioner in the art in order to ascertain the actual metes and bounds of the claimed invention. Such experimentation would be undue, hence the metes and bounds of the invention would not be immediately ascertainable by the routineer in the art by simply looking at the claims.

5. Claims 6, 7, and 9-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the transition metal being from group 4, does not reasonably provide enablement for the transition metal being from groups 5, 6, or the later groups of the periodic table. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The various transition metal groups each have their own unique chemistry and reactivity since each group has its own number of valence electrons. A compound of one transition metal would not likely be completely analogous to a compound of another transition metal, especially if the metals are from different groups. Applicants here urge that an early transition metal compound would be similar in properties and method of preparation to a compound of a late transition metal. However, due to the different electron count and ionic radius of the two metals, that proposition would not likely be true. In the present specification, the sole metal exemplified is titanium; no examples of any other metal, and more pertinently any other group of the periodic table, are given as working examples. Hence one of ordinary skill in the art would be required to engage in extensive undue experimentation in order to ascertain the actual metes and bounds of the present invention.

6. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 5, 7 and 11, the proper format for a closed Markush group is e.g. --E_2 and E_3 are each CR, N or P--.

Further in claim 5, below the reaction arrow for the first reaction should be "- H_2O" since this is a dehydration condensation, and between the two possible products should be "or". In the second reaction arrow, the reduction step should result in hydrogen being on both E_6 and the adjacent carbon atom, contrary to the definitions of R^5 and R^6.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "Y" in claim 7 is used by the claim to mean "Lewis acid (sic)", while the accepted meaning is "yttrium." The term is indefinite because the specification does not clearly redefine the term. A different variable name should be chosen for this variable, preferably one that has no other conventional meaning in synthetic chemistry.

Further in claim 7, the specification defines Y as a Lewis base, not a Lewis acid; this occurs twice in this claim. In the definition of R" above the definition of Y, insert --or-- after "halogen" in the second line for a clear closed Markush group.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term

"B" in claim 13 is used by the claim to mean "cocatalyst", while the accepted meaning is "boron." The term is indefinite because the specification does not clearly redefine the term.

Claim 16 provides for the use of a catalyst, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

7. Claims 1-5, 7 and 16 are objected to because of the following informalities: in claim 16 "olefins" is misspelled. In the other claims the suffixes on the E variables should all be consistently subscripted or on the same line as the E in order to prevent confusion as to whether or not there are missing variables or improper definitions. Appropriate correction is required.

8. The claims are allowable over the prior art of record since all such prior art is drawn to ligands having unsaturation between the two atoms joining the phenyl ring to the thiazole ring.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Pasterczyk

AU 1755

7/31/06

J. A. LORENGO
SUPERVISORY PATENT EXAMINER